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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,398	02/25/2002	Salim G. Kara	61135/P004CP1CP1C2/101074	5850

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

BROOKS, MATTHEW L

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/082,398	Applicant(s) KARA, SALIM G.	
	Examiner Matthew L. Brooks	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-16, 19-25 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 1-15 are objected to because of the following informalities: Applicant states in the preamble "A system comprising:" Yet follows in claims 2-15 "The envelope...". Appropriate correction is required.
2. Claim 25 is objected to because the preamble states "A mail item comprising:" How is it possible that a mail item may comprise a computer system? Appropriate action is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 4-16, 19-25 and 27-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone et al. (4,831,555) as applied to claims above, and further in view of Schuessler (2,964,232).

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Sansone teaches software and computer system for simultaneous generation and printing of a postal item/correspondence and postage indicia thereon, said indicia being machine readable. (Column 2, 1-23 and Column 3, 1-12 and Column 4, 10-15 and C 4 30-55). Sansone further teaches that the computer used is the personal computer is attached to a regular printer (Column 3, 1-7) and that the postage may be printed directly upon a block insert that would be viewable through a window type envelope.

Sansone fails to teach what type of windowed envelope may be used.

Schuessler discloses the envelop as claimed, and that the insertion of a completed document inserted therein. Furthermore, envelope 31 with a front surface that contains three windows 33, 34 & 35, that are covered with glassine, that is cellophane 36, where cellophane 36 protects the contents 10 of envelope 31 while permitting the underlying portions of contents 10 to be viewed from the outside of envelope 31. It is further noted that covered windows 33, 34 & 35 are positioned on the front of envelope 31 such that when:

- A) sender/return address 16,27;
- B) addressee/recipient address 15,26; and
- C) postmark 17,304

which have been printed as part of contents 10 so that when contents 10 has been properly folded and inserted into envelope 31, then the addressee/recipient address 15,26 is clearly viewable through covered window 33 in the lower left portion of envelope 31; the sender/return address 16,27 is clearly viewable through covered

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window 34 in the upper left portion of envelope 31; and the postmark 17,30 is clearly viewable through covered window 35 in the upper right portion of envelope 31.

Further still, Shuessler teaches the use of a windowed envelope as claimed as a convenient method/system/ and apparatus for use in a mailing system and method as being a convenience to insert a prior prepared document into. The business practice of using windowed envelopes for the insertion of an all-inclusive mailing, which allows relevant portions to be displayed, is an old and well-established business practice. This practice is designed to be cost/and time saving by eliminating the need to print on envelopes. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the Sansone method of document and postage indicia generation by software and computer system, the insertion of a fully prepared document (indicia/return address/sender/ and letter content) into a windowed envelope as taught by Schussler, along the lines of the principles established above.

NOTE:

A) it is noted that as would be clearly understood by one of ordinary skill at the time of the invention, both a postage indicia and a cancelled postage stamp provide the same function, that is they each provide proof of the payment of an amount of postage, it would have been obvious to one of ordinary skill that these items are in fact equivalent representations of the same thing.

Response to Arguments

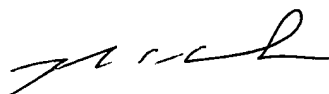
6. Applicant's arguments with respect to claims 1, 4-16, 19-25 and 27-36 have been considered but are moot in view of the new ground(s) of rejection.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patent Numbers: 4,725,718; 4,800,506; 4,868,757; 4,831,554; 5,490,077.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**

1/18/06
MLB